

Remarks

This Application has been carefully reviewed in light of the Office Action mailed July 12, 2005 containing a restriction requirement. Applicant provisionally elects with traverse to prosecute Claims 1 (Group 1-6). Applicant has withdrawn Claims 12-20 without prejudice or disclaimer; however, Applicant respectfully requests that if the Examiner withdraws the restriction with respect to any non-elected claims, the Examiner reinstate and examine those claims. Applicant respectfully requests reconsideration of the restriction requirement in view of the following remarks. Additionally, Applicant has made certain clarifying amendments to Claims 5-6. Applicant respectfully requests reconsideration and allowance of all pending claims in view of the following remarks.

I. Information Disclosure Statement (IDS)

The Examiner indicated in the Office Action that "the non-patent references [cited in the] IDS received 11/12/03 are missing." (Office Action, Page 2) Attached to this Response, Applicant submits a copy of the IDS mailed November 5, 2003, the PTO 1449 form listing the reference, and a copy of the non-patent reference listed on the PTO 1449.¹ Applicant respectfully requests that the Examiner consider the reference. Although Applicant believes that no fee is due for the submission of this reference, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

II. Amendments to Claims 5-6

The Examiner indicated in an Office Action mailed November 13, 2003, that Claims 5 and 6 were objected to as being dependent on a rejected base claim, but that these claims would be allowable if rewritten in independent form, including the limitations of the base claim and any intervening claims. (See 11/13/03 Office Action, Page 8) New Attorney for Applicant noticed that although Claims 5 and 6 were each amended to include the limitations of the base claim (Claim 1 in both cases), neither of Claims 5 and 6 were amended to recite the limitations of their respective intervening claims (Claims 2-4 for Claim 5 and Claims 2-5 for Claim 6). Although the Examiner indicated that Claims 5-6 were allowed in an Office Action mailed September 20, 2004, Applicant suspects that the Examiner did not notice that

¹ Applicant notes that only a single non-patent reference is listed on the PTO 1449.

these claims were amended to include only the limitations of each of the base claim. By making these amendments, Applicant does not admit that these amendments are necessary to overcome the rejections made by the Examiner. Instead, Applicant makes these amendments to expedite issuance of a patent from this Application

III. The Claims Comply with 35 U.S.C. § 112, Second Paragraph

The Examiner rejects Claims 1 and 5-6 under 35 U.S.C. § 112, second paragraph, as reciting a term that allegedly lacks antecedent basis. In particular, the Examiner states that these claims recite the limitation “a log” and that there is insufficient antecedent basis for this limitation. Applicant respectfully disagrees.

Typically, antecedent basis problems arise when a claim includes a limitation preceded by the article “the” or “said” without a prior recitation of the limitation. *See, e.g.*, M.P.E.P. § 2173.05(e) (stating, for example, that a lack of clarity could arise where a claim refers to “said lever” or “the lever,” where the claim contains no earlier recitation or limitation of a lever and where it would be unclear as to what element the limitation was making reference). This is not the case in Applicant’s Claims 1 and 5-6. Instead, the limitation “log” is properly introduced for the first time in each of these claims using the article “a.” Thus, Applicant respectfully submits that there is proper antecedent basis for the limitation “a log” in each of Claims 1 and 5-6.

Additionally, the test for indefiniteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” M.P.E.P. §2173.02 (citing *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986)). Applicant respectfully submits that the meaning of “a log” in Claims 1 and 5-6 would be clear to one of ordinary skill in the art at the time of invention such that these claims comply with 35 U.S.C. § 112, second paragraph.

For at least these reasons, Applicant respectfully requests that the Examiner withdraw the rejections of Claims 1 and 5-6 under 35 U.S.C. § 112, second paragraph.

IV. The Restriction Requirement - Groups I and II Should be Examined in a Single Application

The Examiner requires restriction to one of the following groups:

- I. Group 1: Claims 1-6, which, according to the Examiner, are drawn to a system for recovering a database table, retrieving a backup copy of a tablespace, and the tablespace access system being operable to restrict access to the tablespace to read-only access, classified in class 707, subclass 202; and
- II. Group 2: Claims 12-20, which, according to the Examiner, are drawn to a method for receiving a backup copy of a tablespace, reading the log records associated with a first database table, applying the log records to the backup copy, building a new table of data pages for records, and updating the first database table, classified in class 707, subclass 200.

(Office Action, Pages 2-3)

Applicant respectfully traverses the restriction requirement. There are two criteria for a proper requirement for restriction between patentably distinct inventions: (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. M.P.E.P. § 803. Applicant respectfully submits that at least the second of these two criteria has not been satisfied in this case.

“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” M.P.E.P. § 803.

All pending claims in the present Application have been examined at length. That examination has included at least five Office Actions (excluding the current Office Action) and one Request for Continued Examination filed by Applicant. In the current Office Action, the Examiner indicates that Applicant's arguments presented in the previous Response were persuasive (without any amendments having been made by Applicants in the previous Response) and that the Examiner withdraws the finality of the previous Office Action. (*See* Office Action, Page 2) Thus, the newly-raised restriction requirement has not been caused by any amendment made by Applicant. It is unclear to Applicant why at this stage of prosecution the Examiner is imposing this restriction requirement. Applicant respectfully asks the Examiner: How can there now be a serious burden on the Examiner to search and

examine all pending claims of this Application when the Examiner has already issued at least five previous Office Actions in this case, each addressing all pending claims? Additionally, Applicant respectfully asks the Examiner: What has changed since the previous Office Action to create this purported serious burden on the Examiner to search and examine all pending claims of this Application when the claims were not even amended in the previous Response?

Applicant respectfully submits that the search and examination of all pending claims in this Application may be made without serious burden on the Examiner. Indeed, Applicant respectfully submits that requiring a restriction at this time will seriously burden Applicant, who has already invested considerable time and money into the past examination of these claims. If the Examiner insists on this restriction, Applicant will be forced to examine anew any non-elected claims of the present Application, which will be a considerable waste of expenses and resources of Applicant.

Moreover, Applicant respectfully submits that the search and examination of the Application may be made without serious burden on the Examiner since the claims of Groups I and II clearly recite at least certain substantially similar limitations. The Examiner asserts that the claims of Group I and the claims of Group II fall into different subclasses. The claims of Group I are directed to systems for recovering a database table, and the claims of Group II are each directed to methods of recovering a database table. Applicant notes that in summarizing the limitations recited in the claims of Group II (Claims 12-20) and in concluding that the claims of Groups I and II fall into different subclasses, the Examiner omits that the claims of Group II are directed to methods for recovering a database table. (*See* Office Action, Page 3)

For at least these reasons, Applicant respectfully requests reconsideration and withdrawal of the restriction requirement. Applicant reserves the right to petition the restriction requirement if the restriction requirement is made final.

V. No Waiver

All of Applicant's remarks are without prejudice or disclaimer. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements.

Conclusion

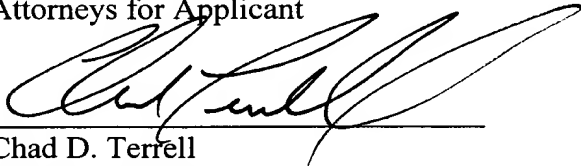
Applicant believes this case is in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests early and favorable action in this case, including the full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Chad Terrell, Attorney for Applicant, at the Examiner's convenience at (214) 953-6813.

Applicant encloses a check in the amount of \$120.00 to cover the cost of a one-month extension-of-time fee. Although Applicant believes that no other fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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Customer Number

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